

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : Maa, Shalong

Application No.: 08/833,342

Art Unit: 3713

Filing Date: April 4, 1997

For: Computer-Controlled Talking Figure Toy with Animated Features



**Commissioner of Patents and Trademarks
Box Petition-to-the-Commissioner
Washington, D.C. 20231**

Dear Sir:

PETITION TO INVOKE SUPERVISORY AUTHORITY OF THE COMMISSIONER, INCLUDING
STATEMENT OF THE FACTS, POINTS TO BE REVIEWED, ACTION REQUESTED AND
PETITION TO SUSPEND RULES IN SUPPORT THEREOF

(37 C.F.R. § 1.181, 1.183)

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This is a petition, to the Commissioner, to invoke supervisory authority of the Commissioner with respect to the prosecution of the above-identified patent application and to the Office Action dated August 02, 1999 (hereinafter sometime referred to as "ACTION", attached hereto as EXHIBIT A) of the Examiner John Paradiso (hereinafter "EXAMINER").

Accordingly, I, Shalong Maa, the applicant of the aforesaid application (hereinafter "APPLICANT"), undersigned, upon personal knowledge and experience, respectfully present to the Commissioner this petition and the following statements pursuant to 37 C.F.R. § 1.181(b):

I. BRIEF SUMMARY OF THE PROCEEDINGS

(1) APPLICANT has received three Office Actions for the above-identified application, dated April 30, 1998; November 11, 1998; and August 02, 1999 respectively, in which, all Claims in the application were rejected in all three Office Actions.

(2) Before the latest Office Action (or the ACTION), a request for CPA (Continued Prosecution Application) was filed on May 10, 1999 via facsimile.

(3) APPLICANT submitted, on July 4, 1999, via facsimile, a substitute Specification and 26 new Claims 35-60, together with detailed arguments and remarks (hereinafter "REMARKS") in response to the previous Office Action dated November 10, 1998 (hereinafter referred to as "PREVIOUS ACTION", attached hereto as EXHIBIT B); APPLICANT have authorized the EXAMINER to cancel all previously-presented Claims 1-34.

(4) APPLICANT was represented by a registered patent attorney - Marc A. Hubbard (hereinafter "ATTORNEY"). On June 11, 1999, APPLICANT revoked the power of attorney for efficiency purpose.

(5) A "Petition to Accept Date of Transmission for Continued Prosecution Application (CPA) for Which P.T.O Has No Evidence of Receipt (37 C.F.R.1.6(f))", prepared by the ATTORNEY†, was filed via facsimile on June 28, 1999 by APPLICANT.

†Note:

The ATTORNEY had suggested APPLICANT to file said petition via direct mail and to include the petition fee required. But the EXAMINER informed APPLICANT, via phone and E-mail, that the ATTORNEY had already authorized him to charge the ATTORNEY's Deposit Account for said petition fee, and it's not necessary for APPLICANT to send the correspondence via direct mail to include payment. Please refer to EXHIBIT C for the printout of a E-mail message sent from the EXAMINER, and Subsection II.(F) hereinbelow regarding said E-mail.

II. STATEMENT OF THE FACTS

(A) Explicit Violation of 35 U.S.C. § 102(b) in the ACTION

In Sections 8-9 (Page 4-5) of the ACTION, the EXAMINER rejected Claims 35, 37, and 43 of the application under 35 U.S.C. § 102(b), as being anticipated by TONG (a prior art reference, Patent Number: 5,636,994, Date of Patent: Jun.10, 1997).

Apparently, rejection under 35 U.S.C. § 102(b) required that the prior art invention was patented "more than one year prior to the date of the application.." as quoted in the ACTION. The non-provisional application filing date of the present case is April 4, 1997, which is more than two month earlier than the patent date of TONG; and the provisional application filing date is April 5, 1996, which is fourteen month earlier than TONG's patent date.

(B) Irrationalness of the ACTION

APPLICANT provided, in the REMARKS, extensive description regarding the differences between the present invention and the prior art references, including detailed arguments in response to the PREVIOUS ACTION, and presented 26 new Claims (Section I (3) hereinabove) for the purpose of illustrating said differences. However, instead of being responsive to APPLICANT's arguments and new Claims, **the majority of the “Claim Rejections” and “Response to Remarks” sections of the ACTION are simply copied from the PREVIOUS ACTION**, as summarized as follows:

- (1) The first paragraph of Page 5 (under Section No. 9) of the ACTION is the same as the last paragraph of Page 3 (under Section No. 4) of the PREVIOUS ACTION except for the added phrase *“in which actuators to move the doll’s body parts”* (2nd line).
- (2) The second paragraph of Page 5 (under Section No. 9) of the ACTION is identical to the first paragraph of Page 4 (under Section No. 4) of the PREVIOUS ACTION.
- (3) The third paragraph of Page 6 (under Section No. 11) of the ACTION is the same as the second paragraph of Page 6 (under Section No. 5) of the PREVIOUS ACTION except for the first word *“However”* in place of the phrase *“Regarding claims 15, 16, 26, and 27”*.
- (4) The last paragraph of Page 6 (under Section No. 12) of the ACTION is identical to the third paragraph of Page 5 (under Section No. 5) of the PREVIOUS ACTION.
- (5) The last paragraph of Page 7 (under Section No. 12) of the ACTION is identical to the last paragraph of Page 5 (under Section No. 5) of the PREVIOUS ACTION.
- (6) The third paragraph of Page 8 (under Section No. 14) of the ACTION is substantially identical to the last paragraph of Page 6 (under Section No. 7) of the PREVIOUS ACTION.

(C) Lack of Understanding of the Invention

APPLICANT believes, In re the following sections of the ACTION, which are two of the few sections not copied from the PREVIOUS ACTION, that the EXAMINER has not yet fully understood some of the basic concepts of the present invention:

- (1) Section 16 on Page 9 of the ACTION - with regard to the basic concept of “frequency” and its relation with “timing unit” or “period” which are clearly presented in the amended Claims.
- (2) Section 7 on Page 4 of the ACTION - with regard to the concept of “digital-signal transfer”, which is described in the specification.

(D) Complete Ignorance of APPLICANT's Remarks and Arguments.

The EXAMINER states on page 8 of the ACTION that "*Applicant's arguments filed 7/2/99 have been fully considered but they are not persuasive*", which is under the "*Response to Remarks*" segment thereof.

However, the entire "*Response to Remarks*" segment of the ACTION presents absolutely no significant response to APPLICANT's arguments and remarks at all; and **the only "descriptive" portion of this "*Response to Remarks*" section of the ACTION is copied from the PREVIOUS ACTION** (Subsection (B)(6) above).

(E) Excessive Errors in the ACTION

Typographical or clerical and other errors in the ACTION are listed as follows:

- (1) Checked Box for indicating "*This action is FINAL*" (2nd line of the middle box on Page 1, or the front "Office Action Summary" page), which, APPLICANT believes, is incorrect†.

† Note:

APPLICANT had two tele-conferences with the EXAMINER on September 24, and October 13, 1999 respectively regarding such error, but have not yet received any correspondence for formal correction thereof from the EXAMINER although the EXAMINER agreed to do so during the second said tele-conference. APPLICANT also had a one-time tele-conference with Ms. Valencia Martin-Wallace, the Supervisory Examiner, on October 12, 1999 during which she confirmed said erroneousness.

- (2) "...*patent Application No. 08/831,342*" (2nd line of Section 1 on Page 2), which should be "...*patent Application No. 08/833,342*"
- (3) "*Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312*" (1st line of Section 2 on Page 2), which, APPLICANT believe, is incorrect, since the 37 CFR § 1.312 is provided for "Amendments after Allowance"
- (4) "*b) Claims numbered 1-26, submitted on 7/2/99 as ..*" (3rd line of Section 3 on Page 2), wherein the date is incorrect, since APPLICANT's record shows that the new Claims were submitted, via fax, after 07/02/99. (Please refer to Subsection I.(3) hereinabove)
- (5) "*The following papers were entered on 7/2/99 as..*" (1st line of Section 5 on Page 3), wherein the date is incorrect (Please refer to Subsection I.(3) hereinabove).
- (6) "*Claims 36 and 38-4 are rejected ...*" (1st line of Section 11 on Page 6), wherein the Claim number "38-4" is certainly incorrect.
- (7) "*Applicant's arguments filed 7/2/99....*" (1st line of Section 13 on Page 8), in which, again, the

date is incorrect (Please refer to Subsection I.(3) hereinabove).

(8) The stamp⁽¹⁾⁽²⁾ showing "Valencia Martin-Wallace, Primary Examiner" (Lower right portion of Page 9)

Note:

(1) According to the one-time tele-conference with Ms. Valencia Martin-Wallace on October 12, 1999 , it was apparent to APPLICANT that Ms. Wallace is the Supervisory Examiner of the group, and was not acting as a Primary Examiner for the present application.
(2) APPLICANT also noticed that Ms. Valencia Martin-Wallace's initial is not shown near said stamp.

(F) EXAMINER's Refusal of Proper Communication

For a period of three week from June 3 to June 24, 1999, APPLICANT send two fax messages and attempted numerous phone calls⁽¹⁾ to the EXAMINER's office trying to schedule a Phone Interview for discussing the PREVIOUS ACTION and APPLICANT's preliminary amendment and argument. Eventually, on June 28, 1999, APPLICANT was granted the long-expected Phone Interview which was schedule at 10:30am on June 30, 1999; the EXAMINER informed APPLICANT, specifically, that he will call APPLICANT at said scheduled time. However, he did not call APPLICANT⁽²⁾ until late afternoon of July 5, 1999 which was after the deadline⁽³⁾ set by the EXAMINER to formally submit amendment and new Claims; instead, the EXAMINER send to APPLICANT a E-mail⁽⁴⁾ stating: "I thought this might be a more convenient and cost-effective way for us to communicate administrative things like interview timing....."

Note:

(1) Please refer to **EXHIBIT D** for copy of APPLICANT's Phone bill, which shows that during said period, there were eleven (11) less-than-two-minute phone calls made to the EXAMINER's office number (703) 308-2825.
(2) APPLICANT did not call the EXAMINER that day because of previous experience.
(3) The EXAMINER requested such deadline (before 07/05/99) during the 6/28/99 tele-conference, claiming his traveling schedule as cause thereof.
(4) please refer to **EXHIBIT C** for the printout of said E-mail.

III. POINTS TO BE REVIEWED

APPLICANT respectfully request that the Commissioner review the following:

(A) Facts Described in Section II Hereinabove in view of the evidence provided, attached hereto as **EXHIBIT A-D**, and APPLICANT's DECLARATION under 37 C.F.R § 1.181 (b) provided

hereinbelow in support of the petition.

(B) ALL Record Entered into the Case File

(C) Communication Means Offered by the Examiner

As described in Subsection I.(4) hereinabove, after APPLICANT revoked the Power of Attorney, the EXAMINER have offered to APPLICANT two new communication means "*for us to communicate administrative things...*" and to "*ensures I receive your fax immediately*" (EXHIBIT C), including : 1) E-mail under address *john.paradiso@uspto.gov*; 2) "*changed fax number for informal faxes: it is the same as my voice number*" : (703)-308-2825.

The APPLICANT believes it is necessary to review the prospect of aforesaid two communication means avoiding routine administrative proceedings of the Office, such as the resulting record of communication and correspondence not being overseen by the supervisory authority or reviewed by technical support staff of the Office.

(D) Stamp Error Described in Subsection (E)(8)

Should the Commissioner deem necessary, APPLICANT expect that cause of the error be reviewed, such as when was the last time that particular stamp was used.

IV. ACTIONS REQUESTED

APPLICANT believes, and in accordance with the rule and regulation of the Office, that each and every applicant should be given the same standard for evaluation of his/her patent application filed in the Patent and Trade Office and the patentability thereof should be solely determined by law; and that "Patent examiners carry the responsibility of making sure that the standard of patentability enunciated by the Supreme Court and by the Congress is applied in each and every case". However, the showing of facts in Section II hereinabove clearly demonstrates to the contrary in APPLICANT's case.

Accordingly, APPLICANT respectfully request, in addition to those described in Section III hereinabove and subject to any rule and regulation of the Office, the following :

(A) Withdrawing the ACTION

As described in Section II of this Petition, there exist excessive errors in the ACTION, some of which are not acceptable, such as incorrect numbering of rejected Claims, and the wrongful rejection of

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claims that would result in statutory bar under 35 U.S.C.102(b); The ACTION is completely unresponsive to APPLICANT's new Claims and arguments provided therefore, and it would not be possible for APPLICANT to properly response to the ACTION; In addition, because of the EXAMINER's default, APPLICANT was not given Phone-Interview before submitting the amendment.

Therefore, APPLICANT respectfully request that the Commissioner withdraw the ACTION.

(B) Assigning Another Examiner.

APPLICANT would like to emphasize that all facts presented in Section II above are in so regard as the EXAMINER's lack of fundamental competence and good faith instead of regarding such technical aspect as detailed ground of rejecting Claims; and that APPLICANT does have doubt about the EXAMINER's intention.

Therefore, APPLICANT respectfully request that the COMMISSIONER assign the present case to another proficient examiner and have the proceeding under close supervision of the Group Director or Supervisory Examiner.

(C) Answer All Materials Traversed in next Office Action

APPLICANT respectfully request that, in the next Office Action, APPLICANT's arguments submitted, including all evidence and/or ground of traverse provided thereto, be fully answered. APPLICANT objects to the EXAMINER's ignorance of APPLICANT's amendment and arguments in the ACTION.

(D) Others

- (1) Should the Commissioner deem necessary, APPLICANT would like to have all record entered into the case file of the present application inspected, and to have a copy of the current specification and pending claims sent to APPLICANT for inspection.
- (2) With regard to the EXAMINER's conduct described herein, APPLICANT would like the Commissioner to consider action pursuant to 18 U.S.C. § 1001 and 18 U.S.C. § 2071.

V. RESPONSE TO THE ACTION

In accordance with 37 C.F.R. § 1.181 (f), the present Petition does not stay the period for reply

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to the ACTION. Accordingly, APPLICANT will respond, *S.M.*, to the ACTION under 37 C.F.R § 1.111, with a copy thereof attached hereto as **EXHIBIT E.** *S.M.*

PETITION TO SUSPEND RULES UNDER 37 C.F.R. § 1.183

--EXTRAORDINARY SITUATION

Pursuant to 37 C.F.R. § 1.181(f), APPLICANT's petition above to Invoke Supervisory Authority of the Commissioner under 37 C.F.R. § 1.181 is untimely since this filing is more than two month after the ACTION. However, APPLICANT believes that the above-described situation is extraordinary, said two-month restriction is not a requirement of the statutes; and APPLICANT did not finish evaluating all the details of the ACTION until after said two-month period.

Accordingly, APPLICANT hereby petitions the Commissioner to accept the PETITION TO INVOKE SUPERVISORY AUTHORITY OF THE COMMISSIONER herein and waive the two month restriction. Enclosed please find the required fee for this petition as set forth in 37 C.F.R. § 1.17(h) and 1.183.

DECLARATION (37 C.F.R § 1.181 (b))

I, the undersigned APPLICANT, hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001.

Respectfully submitted,

By: 

Shalong Maa, Ph.D.

October 27, 1999

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